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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,173	09/16/2003	Thomas P. Jerussi	0701.196A	2834
23405	7590	11/19/2004	EXAMINER	
HESLIN ROTHENBERG FARLEY & MESITI PC 5 COLUMBIA CIRCLE ALBANY, NY 12203			DAVIS, BRIAN J	
			ART UNIT	PAPER NUMBER

1621

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/663,173

Applicant(s)

JERUSSI ET AL.

Examiner

Brian J. Davis

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20, 23-51, 53 and 55-60 is/are allowed.
- 6) ☒ Claim(s) 21, 22, 52, 54 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/16/03; 4/1/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the first inventor has not signed the declaration.

Information Disclosure Statement

The AD entry on the 916/03 IDS has been lined-through as the patent pertains to a device to remove divots – clearly not germane to the instant invention.

Specification

The specification is objected to because Scheme I does not in fact detail the synthesis of the instantly claimed compounds, as stated in paragraph [0015] on page 5, but rather the N-methyl analogs. It is unclear why this is so.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21, 22, 52 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject

Art Unit: 1621

matter which applicant regards as the invention. The exact meaning of the phrases "...a *typical* [emphasis added] antipsychotic agent..." and "...an *atypical* [emphasis added] antipsychotic agent..." is unclear.

Allowable Subject Matter

Claims 1-20, 23-51, 53 and 55-60 are allowed. The following is a statement of reasons for the indication of allowable subject matter:

With respect to claims 1-20, it is well-known in the art that sertraline has four isomers, as evidenced, for instance, by WO 2001049638 (CAPLUS abstract). It is also true that interconversion between these isomers, or their synthesis, does not proceed through the instantly claimed compound PQ. Thus, one of ordinary skill in the art at the time of the invention would have had no motivation to synthesize the instantly claimed compound PQ, despite its close structural similarity to sertraline.

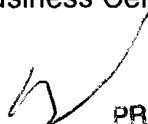
With respect to claims 23-51, 53 and 55-60, the formamide compound of claim 24 is a novel compound. (The compound is used as an intermediate in synthesis claim 23.) The closest prior art appears to be *Organic Letters* (2002), 4(10), p. 1695-1698 (CAPLUS abstract) which teaches, inter alia, the structurally related methyl ester compound. The cited prior art neither teaches nor suggests the instant compounds. Nor would it have been obvious to one of ordinary skill in the art at the time of invention to modify the compounds of the prior art in order to arrive at those of the instant invention. There is no motivation to do so.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 **BRIAN DAVIS**
PRIMARY EXAMINER

Brian J. Davis
November 16, 2004